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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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09/075,375 05/07/98 YAMAMOTO H CGNE119-2US

CALGENE LLC
1920 FIFTH STREET
DAVIS CA 95616

HM12/0201

EXAMINER

ZAGHMOUT, O

ART UNIT

PAPER NUMBER

1649

12

DATE MAILED:

02/01/00

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.
09/075,375

Applicant(s)
Yamamoto et al.

Examiner
Ousama Zaghmout

Group Art Unit
1649



☒ Responsive to communication(s) filed on Jul 22, 1999

☐ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire three month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

Disposition of Claims

☒ Claim(s) 3-5 and 9-11 is/are pending in the application.

Of the above, claim(s) _____ is/are withdrawn from consideration.

☐ Claim(s) _____ is/are allowed.

☒ Claim(s) 3-5 and 9-11 is/are rejected.

☐ Claim(s) _____ is/are objected to.

☐ Claims _____ are subject to restriction or election requirement.

Application Papers

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on _____ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some* ☐ None of the CERTIFIED copies of the priority documents have been

☐ received.

☐ received in Application No. (Series Code/Serial Number) _____

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

☒ Notice of References Cited, PTO-892

☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). _____

☐ Interview Summary, PTO-413

☒ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

Art Unit: 1649

Detailed Office Action

- I. The amendment filed 10/20/1999 has been received and entered.
- II. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.
- III. Status of the claims:

Claims 1-2, 6-8, 12, 15 have been canceled.

Claims 4, 5, 9-11 have been amended [Paper No. 10].

Claims 3, 4, 11 have been amended [Paper No. 11].

Claims 3-5, 9-11 are pending.
- IV. In the Figures, there is more than one than one Figure 8. To distinguish, the Figures should be numbered 8A, 8B, 8C, etc and the specification should be amended to reflect that change.

Claim Rejections - 35 U.S.C. § 112

Ist Paragraph

- I. The rejection of claims 1-2, 4, 8-9 and dependent claims 6-7, 10-15 under 35 U.S.C. 112, first paragraph for not satisfying the requirement of the written description has been withdrawn after the cancellation of claims 1-2, 6-8, 12-15, the amendment of claims 4 and 11, and after further consideration of the record.

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II. The rejection of claims 1-2, 4-15 under 35 U.S.C. 112, first paragraph, for being enabled for the full scope of the invention as claimed has been withdrawn after the cancellation of claims 1-2, 6-8, 12-15, the amendment of claims 4 and 11, and after further consideration of the record.

2nd Paragraph

I. The objection of claims 1-2 for the omission of a sequence identifier, as required by 37 CFR 1.821 (d) has been withdrawn in view of the cancellation of the claims.

2. The rejection of claims 1-2 and dependent claim 10 as being indefinite for the use of relative term "at least" has been withdrawn in view of the cancellation of the claims.

3. The rejection of claims 1-2 and dependent claim 10 for the recitation of "70% homology" has been withdrawn in view of the cancellation of the claims.

4. Claim 3 is objected to for the omission of a sequence identifier, as required by 37 CFR 1.821 (d). The amino sequence shown in line 6 does not have a sequence identifier. Applicants are respectfully requested to comply with sequence rules by submitting a CRF and paper copy of all sequences in this application according to the instructions shown in the MPEP 2427.01. In addition, the specification contains sequences without sequence identifiers (SEQ ID NO) such as pages 17 and 21. Applicants are respectfully requested to comply with sequence rules as mentioned above.

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5. In order to avoid ambiguity in claims 4 and 9, Applicants are respectfully requested to add -- the heterologous promoter-- after the "order of transcription," and before ", the DNA sequence".

DOUBLE PATENT REJECTIONS

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 3-5, 9-11 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-18 of U.S. Patent No. 6,015,939. Although the conflicting claims are not identical, they are not patentably distinct from each other because of overlapping scope.

Conclusion

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Claims 3-5, 9-11 are deemed free of the prior art given the failure of the prior art to teach or suggest the particularly claimed DNA sequence and their usage in transformation experiments.

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Future Correspondence


Any inquiry concerning this communication or earlier communications from the Examiner should be directed to Ousama M-Faiz Zaghmout whose telephone number is (703) 308-9438. The Examiner can normally be reached Monday through Friday from 7:30 am to 5:00 pm (EST).

If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's supervisor, L. Smith, can be reached on (703) 308-3909. The fax phone number for the group is (703) 305-3014.

Any inquiry of a general nature or relating to the status of this application should be directed to THE MATRIX CUSTOMER SERVICE CENTER whose telephone number is (703) 308-0196.

Ousama M-Faiz Zaghmout Ph.D.

January 27, 2000


LYNETTE R. F. SMITH
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 1600